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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,676	07/14/2003	Frederic Legrand	05725.1227-00	4116

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER	
AHMED, HASAN SYED	

ART UNIT	PAPER NUMBER
1615	

MAIL DATE	DELIVERY MODE
06/19/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/617,676	LEGRAND, FREDERIC	
	Examiner	Art Unit	
	HASAN S. AHMED	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 May 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) *23-32* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of applicant's remarks, declaration, and RCE, all filed on 4 May 2009.

* * * * *

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4 May 2009 has been entered.

* * * * *

Response to Amendment

The declaration under 37 CFR 1.132 filed 4 May 2009 is insufficient to overcome the rejection of claims 1-22 based upon Dias in view of Legrand, further in view of Caes as set forth in the last Office action because: the facts presented are not germane to the rejection at issue. For example, the inventive composition was compared with Vaseline, isopropyl palmitate, and isopropyl mysristate. However, the 35 USC 103 rejection over Dias cites a polydecene having more than 19 carbons (see substantive rejection, below), i.e. a polydecene of 20, 30, 40, 50, etc. carbons. The declaration, for instance, does not have a comparison group for a polydecene of 20 carbons. In view of the

foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

* * * * *

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dias (U.S. Patent No. 6,540,791) in view of Legrand, et. al. (U.S. Patent No. 6,260,556), further in view of Caes, et. al. (U.S. Patent No. 6,423,306), further in view of Starch (U.S. Patent No. 5,578,299). All references are presently of record.

Dias teaches a hair bleaching composition and a method of making a hair bleaching composition comprising the polydecene of instant claims 1, 3-5, 18, and 21 (*see* col. 23, line 12), the nonionic amphiphilic polymers of instant claim 16 (*see* col.15, lines 37-48), the peroxygentated salt (perborate) of instant claim 10 (see col. 5, line 27), the alkaline agent (ammonium salts) of instant claims 13 and 14 (see col. 28, line 1), and the surfactants of instant claim 17 (*see* col. 9, lines 52-59). The composition may be in the paste form of instant claims 1, 18, and 21 (*see* col. 49, line 36).

Dias explains that by combining the disclosed ingredients into one composition, "…stable hair bleaching and/or coloring compositions can be made

which are safe and effective for use on mammalian hair and which provide … (increased) shelf-life and bleaching effect benefits…" *See* col. 3, lines 34-38.

The Dias reference differs from the instant application in that it does not disclose the particular peroxygenated salts of instant claim 11 or the hydrogen peroxide of instant claims 21 and 22.

Legrand, et. al. teach anhydrous compositions for bleaching keratin fibers (*see* col. 1, lines 1-13). The disclosed composition consists of, *inter alia*, the sodium persulphate of instant claim 11 (*see* col. 17, line 6), and hydrogen peroxide (see col. 1, line 19).

The Dias reference differs from the instant application in that it does not disclose the gelling agent of instant claims 1, 6-9, 18, 21 and 22.

Caes, et. al. teach cosmetic compositions for use on hair, including pastes (*see* col. 5, line 60; col. 6, lines 30-39).

The disclosed composition consists of the gelling agent of instant claims 1, 6-9, 18, 21 and 22, including the particular hydrogenated block copolymers of instant claim 9 (see col. 3, lines 20-25).

Caes, et. al. explain that use of multi-block copolymers in a cosmetic composition provides the benefits of, "…very good adherence to the substrate, flexibility, wearability, good dry time, non tacky, good retention, non transfer, and low migration over time." *See* col. 1, lines 53-56.

The Dias reference differs from the instant application in that it does not disclose the polydecene of claims 1, 3, 18, and 20-22, in which at least 30 carbon atoms are presented in the claimed formula.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make such a composition by incorporating a polydecene compound having at least 30 carbon atoms because the Dias reference teaches clearly that polydecene compounds having more than 19 carbon atoms can be used in the composition (*see* col. 23, lines 1-12); i.e. a polydecene of 20, 30, 40, 50, etc. carbon atoms. Thus, a person of ordinary skill in the art would be motivated to use hydrocarbon polymers having more than 19 carbon atoms, including those claimed, and would expect such a composition to have similar properties to those claimed, absent unexpected results. In any event, use of polydecene compounds of up to 40 carbons in cosmetic formulations was known in the art at the time the instant application was filed, as shown by Starch (see col. 3, lines 10 and 15).

Dias discloses a polydecene concentration range of 0.05-3% (see col. 22, lines 44-45). A prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). *See* MPEP 2144.05. "The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . .In such a situation, the applicant must show that the particular range is

critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range." In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See MPEP § 716.02 - § 716.02(g) for a discussion of criticality and unexpected results. *See* MPEP 2144.05. The instant application discloses a polydecene concentration as low as 5% (see page 8, p. [041]). Applicants have not shown any criticality between the claimed concentration of 15-35% and the 3% disclosed by Dias.

In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Caes discloses a concentration range of gelling agent (1-70% - see col. 4, line 17) which overlaps with that instantly claimed. Legrand discloses a concentration range of peroxygenated salt (sodium persulfate) (20-70% - see col. 17, lines 7-8) which overlaps with that instantly claimed. Dias discloses a concentration range of alkaline agent (ammonium salt) (0.02-5% - see col. 26, lines 10-11) which overlaps with that instantly claimed.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to make an anhydrous paste comprising a peroxygenated salt, an alkaline agent, a polydecene, and a gelling agent, as taught by Dias in view of Legrand, et. al., further in view of Caes, et. al., further in view of Starch.

One of ordinary skill in the art at the time the invention was made would have been motivated to make an anhydrous paste comprising a peroxygenated

salt, an alkaline agent, a polydecene, and a gelling agent for the beneficial effects of stable hair bleaching and/or coloring compositions which are safe and effective for use on mammalian hair and which provide increased shelf-life and bleaching effect benefits, as well as very good adherence to the substrate, flexibility, wearability, good dry time, non tacky, good retention, non transfer, and low migration over time, as explained by Legrand, et. al. and Caes, et. al.

* * * * *

Response to Arguments

Applicant's arguments filed 4 May 2009 have been fully considered but they are not persuasive.

1. Applicant argues that a rationale has not been articulated as to why a person of ordinary skill in the art would modify Dias to include the gelling agents taught by Caes. See remarks, page 3.

As stated in the substantive rejection (above), like the instant claims, Caes, et. al. teach cosmetic compositions for use on hair, including pastes (*see* col. 5, line 60; col. 6, lines 30-39). Caes, et. al. explain that use of multi-block copolymers in a cosmetic composition provides the benefits of, "...very good adherence to the substrate, flexibility, wearability, good dry time, non tacky, good retention, non transfer, and low migration over time." *See* col. 1, lines 53-56. This is the rationale a person of ordinary skill in the art would have to modify Dias to include the gelling agents taught by Caes.

2. Applicant argues that Dias teaches away from an anhydrous product having a water content less than 1% by weight relative to the total weight of the paste. See remarks, page 3.

As explained in the Office action of 7 March 2008, Dias teaches that the diluent concentration may be as low as 5% by weight of the composition (see col. 45, line 16). Further, the reference teaches that the diluent can be replaced by up to 50% by weight of the total water content (see col. 50, line 41), with the ingredients listed at col. 50, lines 39-44. When these teachings are taken together, Dias discloses a water content as low as 2.5% by weight of the composition. A prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). *See* MPEP 2144.05. "The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . .In such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range." In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See MPEP § 716.02 - § 716.02(g) for a discussion of criticality and unexpected results. *See* MPEP 2144.05. The instant application discloses a water concentration as high as 1% (see page 5, p. [020]). Applicants have not shown any criticality between the concentration disclosed in the instant specification of 1% and the 2.5% disclosed by Dias.

3. Applicant argues that a reason has not been provided as to why a person of ordinary skill would modify the range of polydecene disclosed in Dias to arrive at the claimed range. See remarks, page 3.

As explained in the substantive rejection (above), Dias explicitly teaches the use of polydecenes which contain more than 19 carbons (see col. 23, lines 5-6). Since polydecenes have the formula $C_{10n}H_{[20n+2]}$, the next higher number of carbons after 19 will be 20, 30, 40, etc. As such, the range of carbons recited in instant claim 1 would have been obvious to a person of ordinary skill in the art in view of Dias.

4. Applicant argues that Dias discloses polydecene amongst a long list of organic conditioning oils, including mineral oil and fatty acid esters. See remarks, page 3.

As explained above, examiner respectfully submits that the polydecene of greater than 19 carbons disclosed by Dias, i.e. a polydecene of 20, 30, 40, 50, etc. carbons, reads on the polydecene currently recited in instant claim 1.

5. Applicant argues that the declaration shows the unpredictability of the art and unexpected results attributable to the inclusion of polydecene in the claimed composition. See remarks, page 4.

The declaration was addressed above (see "response to amendment").

☆

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HASAN S. AHMED whose telephone number is (571)272-4792. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward can be reached on (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. S. A./
Examiner, Art Unit 1615

/Humera N. Sheikh/

Primary Examiner, Art Unit 1615